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| 10/729,813 | 12/05/2003 | Biplav Srivastava | JP920030179US1 | 1921 |
| 7590 Frederick W. Gibb, III McGinn & Gibb, PLLC Suite 304 2568-A Riva Road Annapolis, MD 21401 | | | | |
| EXAMINER | | | | |
| PANNALA, SATHYANARAYA R | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,813

Applicant(s)

SRIVASTAVA, BIPLAV

Examiner

Sathyanarayan Pannala

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 17, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 18-29 and 32-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/7/2008 has been entered.

Response to Amendment

2. Applicant's Amendment filed on 10/7/2008 has been entered with amended claims 16-17, 30-31 and cancelled claims 18-22, 32-41. In this Office Action, claims 16-17 and 30-31 are pending.

Claim Objections

3. Claims 16 and 17 are objected, because none of the claims are directed to statutory subject matter. Independent claims 16 deals with simple abstract ideas. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is nonstatutory despite the fact that it might inherently have some usefulness. In *Sarkar*, 588 F.2d at 1335, 200 USPQ at 139. See recent court case, *In-Re Comiskey*,

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, Fed. Cir., 2007 decided 9/20/2007. (see MPEP 2106(IV)(B)(2)(b)(ii)). In this case, claim 16 have to be amended as "computer implemented method" in place of "method" to overcome the objection. Claim 17 is dependent on claim 16 and objected the claim 17 under the same rationale as claim 16.

4. Claim 16 and 30 are objected because of minor error is "if-the-else-rules" instead of "if-then-else rules". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16 and 30 are rejected under 35 U.S.C. 112, second paragraph, as they recites the limitation "said rule system" in claim 16, line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 16 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be

performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps of mapping codes to target rules, representing using which can all be done mentally, and therefore do not qualify as a statutory process. Claim 17 is dependent on claim 16 and rejected under the same rationale as claim 16.

9. Claims 30-31 are rejected under 35 U.S.C. § 101, because claims are directed to program steps. Independent claim 30 is claiming a computer program and functional descriptive material consisting of data structures and computer programs, which impart functionality when employed as a computer component (see table 10, showing the function program). As such, the claims are not limited to statutory subject matter and are therefore non-statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8. Claim 31 is dependent on claim 30 and rejected under the same rationale as claim 30.

10. Claims 16-17 and 30-31 are rejected under 35 U.S.C. § 101, because independent claims 16 and 30 are preemptive and very abstract idea. For example, "interpreting codes" is an impossible situation for "any of laws, policy statements,

contracts, etc." as claimed in 16 and 30. Claims 17 and 31 are dependent claims of 16 and 30 respectively and rejected under the same rationale.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 16-17 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zambo et al. (US Patent 6,985,907) hereinafter Zambo, in view of McCollum et al. (USPA Pub. 2005/0091640 A1) hereinafter McCollum, in view of Bigus et al. (US Patent 7,136,843) hereinafter Bigus, and further in view of Applicant Admitted Prior Art (AAPA).

13. As per independent claims 16 and 30, Zambo teaches a method of codifying field claims with the most severe of the applicable condition codes (col. 2, lines 17-19). Zambo teaches the claimed, an automated method for interpreting codes (col. 2, lines 19-21). Zambo teaches the claimed, mapping said codes to target rules (Fig. 2, col.4, lines 45-61). Zambo teaches the claimed, target rule technology is selected of a

representation of said codes using a rule system (Table 2, col. 6, lines 65-67). Zambo teaches the claimed, providing for said one user's use text of said applicable codes (Fig. 1. Table 1, col. 6, line 56 to col.7 line 14).

Zambo does not explicitly teach rules. However, McCollum teaches the claimed, applying evaluation functions to said target rules that represent said codes, to identify applicable provisions of said codes (Fig. 1, page 2, paragraph [0005]). McCollum teaches the claimed, identifying applicable provisions of said codes based on said first and second evaluations, wherein said applicable codes match said evaluation functions as applied to said target rules (page 1, paragraph [0003]).

Zambo does not explicitly teach applying evaluation function to said rules. However, McCollum also teaches the claimed, applying evaluation functions to said target rules that represent said codes, to identify applicable provisions of said codes, wherein a first evaluation function comprises one user's perspective of said codes, and wherein a second evaluation function comprises a trigger event relating to said codes (Fig. 3, page 14, paragraph [0236]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because McCollum's teachings would have allowed Zambo's method to execute plurality of rules simultaneously instead of executing sequentially in order to use computer resources more efficiently (page 1, paragraph [0003]).

Zambo, McCollum and does not explicitly teach rule system. However, Bigus teaches the claimed, a rule system, said rule system including one of fuzzy rules, if-the-

else-rules, and declarative rules (col. 4, line 64 to col. 5, line 2; col. 4, lines 30-33 and col. 5, lines 15-26). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because McCollum's teachings would have allowed Zambo's method for initialization or setup code is required to intermix with the processing and evaluation of declarative rules-based knowledge (col. 1, lines 64-67).

Zambo and McCollum and does not explicitly teach types of codes. AAPA teaches the claimed, codes comprise any of laws, policy statements, contract provisions, agreements, regulations, rules of association, constitutions, and codes of conduct (page 1, paragraph [0002]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because AAPA's teachings would have allowed Zambo's method to improve using codes (page 1, paragraph [0005]).

14. As per dependent claims 17 and 31, Zambo teaches the claimed, applicable codes comprise a classification codes used for classifying said provisions provided in said document (Fig. 1, Table 1, col. 4, lines 12-20).

Response to Arguments

15. Applicant's arguments with respect to claims 16-17 and 30-31 have been considered but they are not persuasive and details as follows:

a) Applicants' argument regarding 35 U.S.C. 101 objection stated as "Applicant respectfully submits that independent claims 16 is currently amended to recite, in relevant part, 'providing for said one user's use said applicable provisions of said codes'."

In response to Applicants argument, Examiner respectfully disagrees. Because Applicant amended claims 16 and 30 did not overcome the rejection, see the rejection in the above.

b) Applicants' argument regarding rejection of claims under 35 U.S.C. 103 stated as "Nowhere does Zambo disclose, teach or suggest at least the present invention's features..." (see Remarks section, page 10, par. Fourth).

In response to Applicants argument, Examiner respectfully disagrees, because claims 16 and 31 limitation is so broad "**user's perspective**" There is no statutory subject matter. Claims are very broad, as well as preemptive and abstract ideas.

c) Applicants' argument regarding claims 16 and 30 rejection using the prior art stated as "Zambo and McCollum either individually or in combination, do not disclose, teach or suggest at least the present invention features of evaluation target rule..." (see Remarks section, page 11, paragraph two from the bottom).

In response to Applicants argument, Examiner respectfully disagrees, because McCollum teaches as "The purpose of the RDL 100 is to test assertions, enforce constraints using runtime information, make inferences, perform

correlation, and communicate results of dynamic test to other component. In support thereof, the RDL 100 includes a number of statements 102 (also denoted STATEMENT.sub.1, STATEMENT.sub.2, . . . , STATEMENT.sub.N) that facilitate structuring one or more rules 104 for concurrent processing." See at page 2, paragraph [0029]. Every computer programming languages have the target rules and not only prolog computer programming language. There is no requirement of word to word mapping the prior art to claims. Therefore the prior art on record do teach each and every limitation of all claims.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sathyanarayan Pannala/
Primary Examiner, Art Unit 2164

srp
December 19, 2008